

MAR 07 2005

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From: Stephen J. Walder, Jr.	No. of Pages Including Cover Sheet: 11
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Serial No. 09/884,296; Attorney Docket No. AUS920010620US1	
Date: Monday, March 07, 2005	

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MAR 07 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Adler et al.

Serial No.: 09/884,296

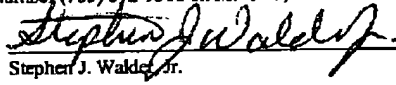
Filed: June 19, 2001

For: Using a Privacy Agreement
Framework to Improve Handling
of Personally Identifiable
Information

§ Group Art Unit: 3621
§
§ Examiner: Reagan, James A.
§
§ Attorney Docket No.: AUS920010620US1
§
§ Customer No. 50170
§

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By: 
Stephen J. Walder, Jr.

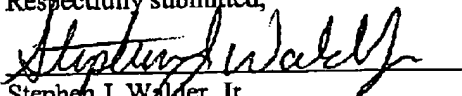
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- Reply Brief (37 C.F.R. 41.41)

No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Deposit Account No. 09-0447.

Respectfully submitted,

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PATENT

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By:

Stephen J. Walder, Jr.

ATTENTION: Board of Patent Appeals and Interferences

APPELLANTS' REPLY BRIEF (37 C.F.R. 41.41)

This reply brief is in response to the Examiner's Answer mailed February 9, 2005.

The fees required under § 1.17(c), and any required petition for extension of time for filing this
brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.(Appellants' Reply Brief Page 1 of 9)
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I. Grouping of Claims

The Examiner's Answer states that Appellants' Brief does not contain a statement that the claims do not stand or fall together and thus, the claims are considered to stand or fall together. Appellants respectfully submit that such a stance is improper in view of the Rules of Practice Before the Board of Patent Appeals and Interferences enacted September 13, 2004. As set forth in the Rules of Practice, the section "Grouping of Claims" is no longer required in Appellants' Brief and the absence of such a section does not constitute an admission by Appellants that the claims stand or fall together.

To the contrary, Appellants have provided arguments both in Appellants' Appeal Brief and herein in Appellants' Reply Brief, illustrating how each of the claims are directed to patentable subject matter. Separate arguments are presented for each of claims 1 and 3-5 with regard to the rejection of these claims under 35 U.S.C. 101 and 35 U.S.C. 103(a). Separate arguments are presented for claim 2 under 35 U.S.C. 101 and 35 U.S.C. 103(a). Separate arguments are presented for each of claims 6-15 under 35 U.S.C. 103(a). Accordingly, Appellants respectfully request that the Board of Patent Appeals and Interferences review the rejections of the claims in view of the grounds of rejection set forth in the Final Office Action and the separate arguments presented by Appellants in both Appellants' Appeal Brief and Reply Brief.

II. Response to Examiner's Remarks Regarding Rejection Under 35 U.S.C. 101

The Examiner's Answer states that the basis of the rejection of claims 1-5 is a two-pronged test comprising the following determinations:

- (1) whether or not the invention is within the technological arts; and
- (2) whether or not the invention produces a useful, concrete and tangible result.

The Examiner then concludes that the presently claimed invention as recited in claims 1-5 does not "advance the technological arts" since, allegedly, all of the recited steps can be performed without the use of any technological apparatus, i.e. the claims fail prong (1) of the

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above two-prong test. Thus, once again, the Examiner is stating that under 35 U.S.C. 101 a rule that the claims must include recitations of a technological apparatus is present, when neither the case law nor the MPEP require such a rule. Accordingly, Appellants' arguments presented in Appellants' Appeal Brief are considered to still apply to the Examiner's remarks set forth in the Examiner's Answer. The Examiner states in the Response to Arguments section of the Examiner's Answer (section 11) that the Examiner does not assert that the claimed invention does not produce a useful, concrete and tangible result.

As stated in section 2106 of the MPEP, the only subject matter that the courts have found to be outside the four statutory categories of invention set forth in 35 U.S.C. 101 is limited to abstract ideas, laws of nature and natural phenomena. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. Thus, if the subject matter is a practical application or use of an idea, a law of nature or a natural phenomenon, then the subject matter is patentable. Nowhere in this requirement of a "practical application" is there any requirement that technological apparatus or means be recited in the claim in order for the claim to be statutory. Of course, reciting technological apparatus or means in the claim would make the claim statutory, but a failure to recite such does not automatically make the claim non-statutory as it would seem the Examiner proposes. To the contrary, even though the claim may not recite technological apparatus or means, the claim may still be statutory as long as it sets forth a practical application or use of an idea, a law of nature or a natural phenomenon.

In the present case, taking claim 1 as exemplary, the claims recite the practical application of the idea of privacy agreements to a method of improving the handling of personally identifiable information which includes the representation of relationships between parties in a process of handling personally identifiable information in a graphically in one or more privacy agreement relationship diagrams. This practical application is then extended by dependent claims 2-5 by mapping business processes to privacy rules that govern the behavior of each pair of parties (claim 2), identifying opportunities to reduce privacy-related risks involved in the process (claim 3), identifying unnecessary exchanges of data for possible elimination (claim 4), and identifying opportunities to transform data into a less sensitive form (claim 5). Thus, the present claims 1-5 clearly recite a practical application and use of privacy agreements to the handling of personally identifiable information. As a result, the claims are directed to a practical

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application of ideas and thus, are statutory subject matter.

Furthermore, the invention as recited in claims 1-5 is clearly directed to a computer-related process. The claims make reference to "data," "process," "data involved in said process," representing privacy agreements "graphically," "business process," "exchanges of data" and the like. Such terminology, when read in light of the specification, clearly illustrates the fact that claims 1-5 are directed to a computer-related process and thus, the requirements for a computer-related process to be statutory should apply to claims 1-5 of the present application.

Under section 2106 (IV)(B)(2)(b), to be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. For a claimed computer-related process to be limited to a practical application within the technological arts (B), the claimed subject matter must produce something that is concrete, tangible and useful. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). Thus, the two-prong test espoused by the Examiner is actually incorrect. There is not a separate determination as to whether the claimed subject matter is "in the technological arts" and a separate determination as to whether the claimed subject matter produces a concrete, tangible and useful result. To the contrary, as long as the claimed computer-related process produces a concrete, tangible and useful result, the process is directed to a practical application within the technological arts.

In the present case, as stated above, the Examiner admits that the claimed computer-related process produces a concrete, tangible and useful result (see section 11 of the Examiner's Answer). Therefore, the Examiner agrees that claims 1-5 produce a concrete, tangible and useful result, and thus are directed to a practical application in the technological arts. Accordingly, claims 1-5 are directed to statutory subject matter.

Moreover, the claimed invention as recited in claim 1 results in one or more graphical privacy agreement relationship diagrams that represent the relationships between parties involved in a process of handling personally identifiable information. This is a concrete, tangible and useful result generated by a computer-related process. As such, the claimed subject matter is limited to a practical application within the technological arts. Therefore, the claimed computer-related process is statutory. Furthermore, claims 2-5 provide additional practical applications of

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the present invention including mapping business processes to privacy rules that govern the behavior of pairs of parties in the process for handling personally identifiable information (claim 2), identifying opportunities to reduce privacy-related risks involved in the process of handling personally identifiable information (claim 3), identifying unnecessary exchanges of data (claim 4), and identifying opportunities to transform data into a less sensitive form (claim 5).

In view of the above, Appellants respectfully submit that the rejection of claims 1-5 under 35 U.S.C. 101 is improper and should be overturned. Accordingly, Appellants respectfully request that the Board of Patent Appeals and Interferences overturn the rejection of claims 1-5 under 35 U.S.C. 101.

III. Response to Examiner's Remarks Regarding Rejection Under 35 U.S.C. 103

The arguments presented with regard to the various combinations of the references King, Kroenke and Spies, set forth in Appellants' Appeal Brief, are believed to still be applicable to the present rejections in view of the Examiner's Remarks in the Examiner's Answer. The following remarks are provided to address certain points raised by the Examiner in the Examiner's Answer.

In section 11 of the Examiner's Answer, under the title "Issue 2", the Examiner states that a suggestion or motivation to combine the King and Kroenke references is present in the references at least at paragraph 007 of King and pages 59+ of Kroenke because both make reference to Business Rules. Appellants have reviewed paragraph 007 of King and do not find any reference to "business rules" in this paragraph of the reference. What is stated is that the exchange of sensitive information may be governed by one or more privacy agreements established between the principle parties, i.e. a client device and a server device. King also states in this paragraph that a proxy server can manage a list of realms that are allowed sensitive information and may be used to negotiate privacy agreements. However, nowhere in this section of King is there any mention of "business rules" as alleged by the Examiner.

At page 59+, the Kroenke reference describes a database schema that consists of tables, relationships, domains and business rules. The business rules are added to the database schema during a data modeling stage. While Kroenke teaches the inclusion of business rules in a database schema, this does not provide any teaching or suggestion to combine Kroenke with King.

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King is clearly directed to a system and method for controlling the transfer of sensitive information between a client device and a server device based on established privacy agreements between the client device and the server device. While King mentions privacy agreements and using them to control the transfer of information, nowhere in King is there any teaching or even suggestion to represent parties, data, and privacy agreements graphically in one or more privacy agreement relationship diagrams or that the privacy agreements use a limited number of privacy-related actions concerning the personally identifiable information. The Examiner does not contest this lack of teaching in King and in fact admits that King lacks such teachings. However, contrary to the Examiner's allegations, Kroenke does not teach or suggest these features either.

Kroenke is a general textbook describing database processing, and happens to have a section directed to entity-relationship modeling using a database schema. A number of diagrams are shown for illustrative purposes to explain examples of relationships between entities that may be represented in a database schema. While these diagrams are present in the textbook of Kroenke, these diagrams are merely illustrative of examples for explaining the entity relationship model and do not teach or even suggest to generate privacy agreement relationship diagrams to represent parties, data and privacy agreements of a process of handling personally identifiable information. That is, while Kroenke provides diagrams of relationships between entities for explanation of a database schema, there is no actual teaching in Kroenke to take data of a process for handling personally identifiable information, information regarding relationships between pairs of parties in a privacy agreement, and representing this information in a graphical form as one or more privacy agreement relationship diagrams. Thus, neither Kroenke nor King, either taken alone or in combination, teach or suggest representing parties, data and privacy agreements graphically in one or more privacy agreement relationship diagrams, as recited in claims 1, 6 and 11. Furthermore, there is no teaching or suggestion to combine Kroenke and King in the manner alleged by the Examiner.

King and Kroenke are not directed to solving a similar problem using computer implemented methods, despite the allegations made by the Examiner. King is concerned with controlling the transfer of sensitive information between a client device and a server device by using privacy agreements. Kroenke describes a database schema that may be used with the entity-relationship model. These are not the same problem. In fact, there is no discernable problem addressed by Kroenke. Kroenke merely provides an explanation of a database schema.

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Thus, the Examiner's allegation that King and Kroenke are directed to solving the same problem is erroneous and not supported by the actual teachings of the references.

Moreover, the Examiner's statement that because both references may mention business rules, that somehow they now become combinable, is also a mistaken attempt to support a combination of teachings from non-analogous references. Merely mentioning business rules and that business rules may be added to the database schema in Kroenke does not give any teaching or suggestion to combine Kroenke with King. Many different systems may make use of business rules and yet not be combinable with the system and method described in King. The mere mention of business rules in some later section of Kroenke does not provide any teaching, suggestion, or motivation to combine the concept of generating relationship diagrams, allegedly taught by Kroenke although Appellants disagree for the reasons stated above, with the teachings of King. To the contrary, the Examiner's pointing to "business rules" as a way of linking the references is a mere attempt to support a combination that is based on two non-analogous references that do not provide any motivation to combine their features by finding any possible commonality regardless of how irrelevant it is to the features that are allegedly being combined.

Even if the teachings of Kroenke were somehow combinable with the teachings of King, the result still would not be the invention as recited in independent claims 1, 6 and 11. That is, as stated above, neither reference, either alone or in combination, teaches or suggests to represent the entities, data and relationships between entities, of a process of handling personally identifiable information, graphically as one or more privacy agreement relationship diagrams. Thus, any combination of the references, even if such references were somehow possible and a motivation were provided for such a combination, would still not result in all of the features of independent claims 1, 6 and 11 being taught or suggested. Thus, the rejection of claims 1, 2, 6, 7, 11 and 12 under 35 U.S.C. 103(a) based on King and Kroenke is improper and should be overturned by the Board of Patent Appeals and Interferences.

With regard to claim 2, the Examiner states that Appellants are reading in features from the specification into the claims and thus, the arguments are not persuasive. Appellants respectfully disagree and point to the specification only as exemplary of the features recited in the claim 2. Nowhere in either King or Kroenke is there any teaching or suggestion to map a business process to privacy rules that are to govern the behavior of pairs of parties. While Kroenke may mention "business rules" and that business rules may be added to a database

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schema, there is not teaching or suggestion in Kroenke to map business processes to privacy rules of a privacy agreement that govern the behavior of pairs of parties in a process for handling personally identifiable information, as recited in claim 2. Merely teaching that generally, business rules may be added to an entity-relationship model used with a database schema does not provide any teaching or suggestion to perform the specific functionality recited in claim 2.

With regard to the rejection of claims 3-5, 8-10 and 13-15, these dependent claims are distinguished over the alleged combination of references at least for the same reasons as noted above with regard to claims 1, 6 and 11. The Spies reference does not provide any teaching or suggestion to cure the deficiencies noted above with regard to King and Kroenke. Spies teaches yet another field of technology – encryption. Thus, in the rejections of claims 3-5, 8-10 and 13-15, not only is the Examiner attempting to combine the non-analogous King and Kroenke references, but is now adding a third reference, Spies, that is directed to a completely different area of technology than King and Kroenke.

Merely because Spies may generally teach to mitigate risk associated with personal, sensitive information by reducing or restricting access to this information, this general teaching does not render the specific features recited in the dependent claims 3-5, 8-10 and 13-15 unpatentable. To the contrary, Spies teaches a specific way in which to reduce access to information – encryption. Nowhere in Spies is there any teaching or suggestion to identify opportunities to reduce privacy-related risks involved in a process of handling personally identifiable information, as recited in claim 3. Moreover, nowhere in Spies is there any teaching or suggestion to identify unnecessary exchanges of data, as recited in claim 4, or identifying opportunities to transform data into a less sensitive format, as recited in claim 5. The Examiner merely states that these features are obvious because Spies gives a general concept that one would want to reduce access to information in order to mitigate risk. The Examiner is using a general concept to reject specific features. The general concept does not obviate all specific implementations of the general concept and thus, the general concept in this case does not obviate the specific features recited in claims 3-5, 8-10 and 13-15. The fact is, the references simply do not teach or suggest the specific features recited in these claims, despite the allegations made by the Examiner regarding the general goal of reducing access to information in order to mitigate risk.

As with the rejection of claims 1, 6 and 11 discussed above, the Examiner's rejections are

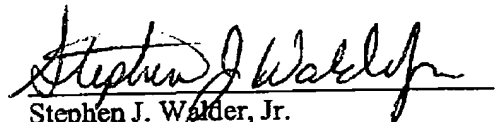
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completely based in a hindsight reconstruction of the claims using non-analogous art from a variety of different fields of technology in an attempt to recreate the claimed invention having first had benefit of Appellants' disclosure. One of ordinary skill in the art would not have found it obvious, without first having benefit of Appellants' disclosure, to combine and modify the teachings of the references in the particular way necessary to arrive at the present claims. The hindsight that is rampant in the rejections made by the Examiner is clear not only from the non-analogous nature of the references sought to be combined, but also in the lack of teachings of these references with regard to the specific features recited in the claims.

IV. Conclusion

In view of the above, Appellants respectfully submit that claims 1-15 of the present application are directed to statutory subject matter and that the features of these claims are not taught or suggested by the King, Kroenke, and Spies references. Accordingly, Appellants request that the Board of Patent Appeals and Interferences overturn the rejections set forth in the Final Office Action.

Respectfully submitted,


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